

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Bonilla Patent Application
Application No.: 10/628,960 Group Art Unit: 2192
Filed: July 28, 2003 Examiner: Dao, Thuy Chan
For: AN EMULATION AND NATIVE LANGUAGE INTERFACE TESTING
SYSTEM AND METHOD

REPLY BRIEF

In response to the Examiner's Answer mailed on December 28, 2007, Appellant respectfully submits the following remarks.

200309109-1
Serial No.: 10/628,960

Group Art Unit: 2192

REMARKS

Appellant is submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellant is addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellant agrees with the other arguments presented in the Examiner's Answer.

Grounds of Rejection (§9), page 4 - page 9 of Examiner's Answer

Appellant notes that in the Examiner's Answer, new grounds of rejection have been added to supplement the previous rejections of Claim 1 and Claim 5. Certain of these new grounds are discussed herein. Appellant submits that these additions, in particular with respect to Claim 1, provide further examples of parsing the text of the cited art to reconstruct Appellant's claims from selected bits and pieces of the cited art that are not part of a single method or system such as the methods and systems recited by Appellant's claims. Due to the explanation and rationalization in rejecting the claims, particularly Claim 1, it appears to the Appellant that the rejection of the Claims has taken the form of an obviousness rejection which has been made under the auspices of an anticipation rejection. Appellant respectfully points out that, in comparison to an obviousness rejection, the bar is set much high for making a *prima facie* case of anticipation. For example:

According to MPEP 2131, "to anticipate a claim, the reference must teach every element of the claim." Further, as cited in MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, according to MPEP 2131, "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (emphasis added)

As discussed in the Appeal Brief and as additionally discussed below, Appellant submits that the Rejection has failed to show that every element of the Claims has been taught by the cited art. Moreover, such parsing, rationalization, and construction of the claim elements from bits and pieces of the cited art, show that the Appellant's invention does not exist as a single anticipated system or method within the cited art. In spite of this, the Rejection and Examiner's Response attempt to reconstruct the Claims piece by piece by parsing the cited art using hindsight and the claims as a blueprint. Appellant understands that identity of terminology does not need to exist between the cited art and the instant Claims and that some amount of explanation is proper, however, Appellant submits that this type of explanation is not the issue, but rather: 1) that the invention defined by the instant claims does not exist within the cited art unless constructed piecemeal as the Rejection has attempted, and 2) that even in view of the attempts to construct the claims in a piecemeal fashion from the cited art, not all claim elements are taught (either expressly or inherently) in the cited art.

Claim 1

Appellant notes that the Examiner's Answer has cited additional grounds for rejection of Claim 1. Claim 1 recites the feature of "...wrapping native language code in a simulation test macro which creates simulated interfacing problems..." The Final Rejection (mailed 4/30/2007) rejected this claim feature by citing to "...col. 1: 7-11, debugging a Java application that includes native method dynamic load libraries; col. 2: 15-22, a first 'daemon' process that performs native method debugging..." of U.S. Patent No. 6,826,746 to "Evans" et. al (see e.g., Final Rejection page 3 and Final Rejection page 5). In the Examiner's Answer, the following new grounds of

rejection were additionally cited with respect to this claim feature “...FIG. 4, col. 5: 65-66 and col.6: 3-4, ‘simulation test macro’ as probe function/launch method 46; col.5: 64 - col.6: 5, wrapping/containing native language code C/C++...,” see rejection of Claim1 on page 4 of Examiner’s Answer. Appellant notes that no explanation was provided to highlight what it was thought was relevant in this additionally cited section of Evans.

Appellant submits that the additional citations to Evans provide no support for the anticipation of “...wrapping native language code in a simulation test macro which creates simulated interfacing problems...” as recited in Claim 1. For example, per Appellant’s understanding, Figure 4 appears to show components for and “the process of connecting to the JVM,” see col. 5, lines 47-52 of Evans. However, nothing in Figure 4 teaches either implicitly or inherently “...wrapping native language code in a simulation test macro which creates simulated interfacing problems...,” as is recited in Claim 1. The Examiner’s Answer seems to contend that that this claim feature is taught in col. 5, lines 65 - col. 6, line 5. However, while a detailed procedure for launching an application appears to be described, nothing is mentioned regarding “wrapping native language code in a simulation test macro which creates simulated interfacing problems ...” as recited in Claim 1.

Additionally, the Examiner’s Answer appears to liken a “probe” or “launch method” in the cited text to a “simulation test macro.” However, per Appellant’s understanding a probe as described in the cited text appears to be very different from a “native language code” wrapped in a “simulation test macro,” and no explanation (articulated or otherwise) has been provided to explain why they are the same. In contrast to this contention, Figure 2 shows the probe 41 as

separate from an application. Moreover, Figure 6 shows a detailed view of the probe 41, and although the probe contains numerous modules it does not appear to contain or be wrapped about native language code. Finally, although C++ code is discussed in Evans, no teaching supports the apparent contention the probe/launch process comprises “wrapping/containing native language code C/C++.” For at least these reasons, Appellant continues to assert that this feature of Claim 1 is not taught either expressly or inherently by Evans, and as such a *prima facie* case for anticipation of Claim 1 by Evans has not been made.

Claim 5

Appellant notes that the Examiner’s Answer has cited additional grounds for rejection of Claim 5.

Claim 5 recites the feature of “...means for storing said information, including instructions for testing said Java Native Language Interface, said means for storing said information coupled to said means for communicating information...” The Final Rejection rejected this claim feature by citing to “col.6: 52-57; col.8 15-19 col. 8 25-col.9: 67; FIG 13, data sent to application, data output from application” (see discussion of Claim 5 on page 3 and again on page 6 of the Final Rejection). In the Examiner’s Answer, the following new grounds of rejection were additionally cited with respect to this claim feature “...col.4: 65 - col.5: 17; col.5 18-46...” see rejection of Claim 5 on page 5 of Examiner’s Answer. Appellant notes that no explanation was provided to highlight what it was thought was relevant in this additionally cited section of Evans.

Appellant submits that the additional citations to Evans provide no support for the anticipation of "...means for storing said information, including instructions for testing said Java Native Language Interface, said means for storing said information coupled to said means for communicating information..." as recited in Claim 5. For example, although the cited text describes "[a] users graphical user interface...to allow the user to...input commands to load processes, set breakpoints, etc...," (see col. 5, lines 2-4), Appellant submits that inputting such instructions is not the same as and does not anticipate "storing" such instructions. While a computer is capable of storing such instructions, there appears to be no indication that such storing of instructions input via the GUI takes place. Thus, even after further consideration of the newly cited text, Appellant submits that Evans does not teach, either expressly or inherently, a "means for storing said information, including instructions for testing said Java Native Language Interface," as is recited in Claim 5. For at least this additional reason, Appellant continues to assert that Claim 5 is not taught either expressly or inherently by Evans, and as such a *prima facie* case for anticipation of Claim 5 by Evans has not been made.

Response to Argument Section (§10), page 10 - page 21 of Examiner's Answer

On page 11 the Examiner's Answer contends (emphasis added):

Furthermore, wherein the reference Evans is used under 35 USC 102 rejection and set forth as a single invention (i.e., "the present invention will be referred to as "ICAT2", col.4: 19-20), however, Appellant merely pointed out different locations recited in the rejection and submitted "...that such parsing of Evans is improper and does not satisfy the *prima facie* showing required for establishing anticipation..." (Brief, page 9, second paragraph) without any analysis to show why and how "cited art is not 'arranged as in the claim'"

Appellant disagrees with this contention and specifically points to the second paragraph of Argument 1A on page 9 of the Appeal Brief. In addition to describing the various parsed

portions of Evans, Appellant submitted that “...these portions of parsed information are not part of a single method recited by Evans and do not appear in Evans arranged as required by Claim 1.”

On page 16 the Examiner’s Answer contends (emphasis added):

Furthermore, wherein the reference Evans is used under 35 USC 102 rejection and set forth as a single invention (i.e., “the present invention will be referred to as “ICAT2”, col.4: 19-20), again, Appellant merely pointed out different locations recited in the rejection and submitted “...that such parsing of Evans is improper and does not satisfy the prima facie showing required for establishing anticipation...” (Brief, page 14, first paragraph) without any analysis to show why and how “cited art is not ‘arranged as in the claim’”

Appellant disagrees with this contention and specifically points to the second paragraph of Argument 2A on pages 13-14 of the Appeal Brief. In addition to describing the various parsed portions of Evans, Appellant submitted that “...these portions of parsed information are not part of a single system embodiment recited by Evans and do not appear in Evans as arranged in Claim 5.”

On page 19 the Examiner’s Answer contends (emphasis added):

Furthermore, wherein the reference Evans is used under 35 USC 102 rejection and set forth as a single invention (i.e., “the present invention will be referred to as “ICAT2”, col.4: 19-20), again, Appellant merely pointed out different locations recited in the rejection and submitted “...that such parsing of Evans is improper and does not satisfy the prima facie showing required for establishing anticipation...” (Brief, page 18, second paragraph) without any analysis to show why and how “cited art is not ‘arranged as in the claim’”

Appellant disagrees with this contention and specifically points to the second paragraph of Argument 3A on page 16 of the Appeal Brief. In addition to describing the various parsed portions of Evans, Appellant submitted that “these portions of parsed information are not part of a single method recited by Evans and do not appear in Evans as arranged in Claim 9.”

Lastly, on page 11 (and similarly on pages 16 and 19), the Examiner's Answer characterizes the Appellant's argument against the *prima facie* case of anticipation as follows:

...Appellants argument amounts to mere statements and assertions which are not directed to any figures/text portions relied by the examiner in the rejection nor reply to every ground of rejection, nor point out the supposed errors in said figures/text portions as set forth in the previous office action - see MPEP, Appendix R - Patent Rules, Action by Applicant and Further Consideration, 37 C.F.R. section 1.111(b).

Appellant submits that the referenced arguments were, and are, valid arguments that a *prima facie* case of anticipation was not made by the Rejection. Appellant further submits that the arguments were in compliance with 37 C.F.R. §1.111(b) as they specifically pointed out a "supposed error in the Examiner's action." Moreover, through two cycles of office actions, Appellant believes that every ground of rejection and objection was responded to, to include amendments to address objections to portions of the specification, claims, and figures. Indeed, such contentions that the "...Appellant's argument amounts to mere statements and assertions" appear to be attempts to evade addressing what Appellant believes were valid arguments that a *prima facie* case of anticipation was not made by the Rejection.

CONCLUSION

For reasons presented above and for reasons previously presented in the Appeal Brief, Appellant continues to assert that the embodiments of Claims 1-20 are not anticipated by the cited art. Thus, Appellant respectfully requests that the rejections of Claims 1-20 be reversed.

The Appellant wish to encourage the Examiner or a member of the Board of Patent Appeals to telephone the Appellant's undersigned representative if it is felt that a telephone conference could expedite prosecution.

Respectfully submitted,

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Dated: 2/28/2008

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